

REMARKS

Claim Amendments

In the present Amendment, claims 1, 19, 20 and 21 are amended to clarify that the polyaminopolycarboxylic acid anhydride is added to a mixture of the compound having an amino group and the polyaminopolycarboxylic acid, or the compound having an amino group and the polyaminopolycarboxylic acid anhydride are added to the polyaminopolycarboxylic acid. Support for this amendment resides at dependent claims 9 and 10. No new matter is added by this amendment.

Allowable Subject Matter

Applicants acknowledge the indication of allowable subject matter of claim 19 to the extent limited to the elected species. However, for the reasons indicated below, all pending claims are believed to be directed to allowable subject matter.

Interview with Examiner

Applicants thank the Examiner's supervisor for the courtesy extended toward his representative during the interview of November 19, 2007. During the interview, the distinctions between the claimed invention and the cited prior art were discussed. While no agreement was reached during the interview, the Examiner's supervisor indicated that the above claim amendments may assist in overcoming the anticipation rejection.

Issues under 35 U.S.C. 102(b)

Claims 1, 2, 9-14, 17 and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Paik *et al.*, *J. Nucl. Med.*, Vol. 24, pp. 1158-1163 (1983) (see pages 3-4 of the Office Action). Applicants respectfully traverse and reconsideration is based on the following remarks.

As recited in instantly pending claims 1 and 19-21, the present invention is directed to a process for producing an amide compound, which comprises reacting a compound having an amino group with a polyaminopolycarboxylic acid anhydride in the presence of the polyaminopolycarboxylic acid.

Not all instantly claimed features are disclosed in the Paik *et al.* reference. In the Office Action, the Examiner states that the cited Paik *et al.* reference teaches the instantly claimed method of amide formation. But Applicants note that a polyaminopolycarboxylic acid is not even disclosed in Paik *et al.*

The Paik *et al.* reference discloses a DTPA anhydride molecule having two anhydride moieties, and an acetic acid residue shows absorption bands which are characteristic of the anhydride carbonyl groups and carboxylate. However, Paik *et al.* do not teach that there is DTPA which has five free acetic acid residues. In other words, the requirements of the instantly claimed process are not fulfilled by the presence of a single acetic acid residue on a single DTPA anhydride molecular since the claimed process is conducted in the presence of a polyaminopolycarboxylic acid.

Instead, Paik *et al.* disclose that due to hydrolysis of the anhydride, the reaction reduced the pH of the buffer solution (see pp. 1159+). This merely teaches that the desired acylation of one anhydride group resulted in formation of an acetic acid residue but it does not mention that the **polyaminopolycarboxylic acid** *per se* was present or added to the reaction.

Therefore, the claimed **polyaminopolycarboxylic acid** was not added to the Paik *et al.* reaction, and it cannot be said that the reaction as disclosed in Paik *et al.* was conducted in the presence of the polyaminopolycarboxylic acid. Thus, because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited Paik *et al.* reference cannot be a basis for a rejection under 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Paik *et al.* is overcome. Reconsideration and withdrawal are respectfully requested.

In addition, the instantly claimed process shows a superior results as compared to the comparative example of the present specification where the polyaminopolycarboxylic acid was not used in the reaction. Applicants understand that the instant rejection is cited under 35 U.S.C. §. 102. Still, evidence of unexpected results resides in the present specification and it is improper to not consider such evidence of patentability for the present invention. See *In re Soni*, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) (error not to consider evidence in the specification); M.P.E.P. § 2144.08(II)(B).

Applicants also note the Examiner's statement at page 4 of the Action that "The claims in the instant application do not recite that polyaminopolycarboxylic acid is added to the reaction mixture", with the claim merely stating "reacting a compound having an amino group with a polyaminopolycarboxylic acid anhydride in the presence of the polyaminopolycarboxylic acid."

While Applicants believe that the Examiner ignores the plain wording of the claim in reaching this conclusion, Applicants amend claims 1 and 19-21 to clarify that "the polyaminopolycarboxylic acid anhydride is added to a mixture of the compound having an amino group and the polyaminopolycarboxylic acid, or the compound having an amino group and the polyaminopolycarboxylic acid anhydride are added to the polyaminopolycarboxylic acid."

The cited reference clearly fails to teach or suggest such an embodiment. The Examiner asserts at page 4 of the Action that the cited reference "clearly teaches that the DTPA anhydride hydrolyzes in the presence of water (page 1158, column 2)", with the requisite reaction occurring in the presence of polyaminopolycarboxylic acid due to the presence of hydrolyzed product of the DTPA anhydride being present in the reaction mixture. In other words, any acid which is present is due to its *in situ* formation.

Claims 1 and 19-21 now distinguish over such an embodiment by requiring that "the polyaminopolycarboxylic acid anhydride is added to a mixture of the compound having an amino group and the polyaminopolycarboxylic acid, or the compound having an amino group and the polyaminopolycarboxylic acid anhydride are added to the polyaminopolycarboxylic acid". The reference cannot be said to anticipate the claimed invention.

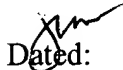
The rejection under 35 U.S.C. § 102(b) is thus without basis and should be withdrawn.

CONCLUSION

In view of the above, the application is believed to be in condition for allowance, and an early indication of same earnestly is solicited.

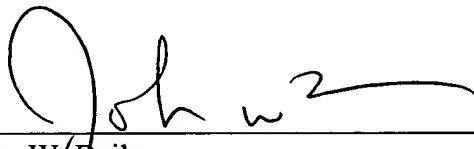
Payment in the amount of \$120.00 is submitted herewith as payment for the requested one month extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


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